

No. 14,617

IN THE

**United States Court of Appeals
For the Ninth Circuit**

UP-RIGHT, INC., a corporation, and WALLACE
J. S. JOHNSON,

Appellants,

vs.

THE PATENT SCAFFOLDING Co., INC.,
a corporation,

Appellee.

**BRIEF ON BEHALF OF APPELLANTS,
UP-RIGHT, INC. AND WALLACE J. S. JOHNSON.**

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STATEMENT OF THE PLEADINGS.

This cause was tried upon issues joined by an Amended Complaint (R. 6), filed by appellants, Up-Right, Inc. and Wallace J. S. Johnson, as the exclusive licensee and owner, respectively, of United States Letters Patent No. 2,618,496 (R. 232), seeking a judgment as against appellee, The Patent Scaffolding Company, Inc., for infringement of said patent, and the Answer to Amended Complaint (R. 9) filed by appellee.

Following the trial¹ and submission of briefs before the United States District Court for the Northern District of

¹The evidence was taken before a jury but at the conclusion of the evidence the parties stipulated (R. 225-227) that the jury be dismissed and the case submitted to the judge for decision.

California, Southern Division, a Memorandum Decision (R. 13) was filed by Judge Goodman, who thereafter entered Findings of Fact and Conclusions of Law (R. 14) and a Judgment (R. 22) adjudging the patent in suit to be invalid and void. The Judgment (R. 22) was filed November 18, 1954 and within 30 days thereafter, to wit, on December 7, 1954, appellants filed a Notice of Appeal (R. 23), together with a Bond for Costs on Appeal (R. 24).

JURISDICTION.

The jurisdiction of the District Court was based upon the patent laws of the United States, namely, Section 1338(a) of Title 28 of the United States Code. The jurisdiction of this Court over this appeal is based upon Section 1291 of Title 28 of the United States Code.

THE PARTIES.

The appellant, Wallace J. S. Johnson, is the inventor named in the patent in suit and is a resident of California; and the appellant, Up-Right, Inc., is a corporation of California, having its place of business at Berkeley, California, and is an exclusive licensee under said patent and manufactures and sells the patented scaffold.

The appellee, the The Patent Scaffolding Company, Inc., is a corporation of New York, having a place of business in the City and County of San Francisco, State of California.

CONCISE ABSTRACT OR STATEMENT OF THE CASE.

The patent in suit, No. 2,618,496 (R. 232), was issued on the invention of appellant Johnson on an application filed September 15, 1947. Just prior to that date, appellant Johnson caused the corporate appellant, Up-Right, Inc., to be formed to manufacture and sell scaffolds embodying the invention² and granted the corporate appellant an exclusive license under the patent.

The scaffolds embodying the invention were immediately commercially successful and created a new conception of scaffolding within that industry. From the inception of the corporate appellant to the time of filing suit, it manufactured and sold approximately 20,000 scaffolds using some 79,500 of the patented legs (R. 101) which were sold throughout the entire United States.

After the commercial acceptance of the appellants' scaffold, and before issuance of the patent in suit, the appellee (long in the general scaffold business) precisely copied the patented structure and embodied it into its scaffold admittedly because the customers demanded it and would not purchase ladder-type scaffolds without it.

Promptly upon issuance of the patent, this action was commenced for patent infringement.

Appellee pleaded the usual defenses of invalidity of the patent and non-infringement. The defense of invalidity was based on the showings of eleven prior patents, none of which discloses a device intended to produce, or capable of producing the results of the patented structure, or sub-

²This was not urged at the trial in that the only evidence was that the accused device was a precise copy of the patented structure.

stantially similar to the patented structure in construction or mode of operation. The District Judge, however, found the various elements of the patented structure separately in these prior patents and held (R. 13-14): “In my opinion, all of the elements aggregated by plaintiffs function as taught in the prior art patents. Plaintiffs did not change nor bring to light anything new in the functioning of these elements. Hence the result is aggregation and not a patentable combination”; and found (R. 16): “The essential elements of the single claim of the patent in suit are disclosed in the patents to: Countryman, 1,912,475; Taylor, 747,270; Burns, 1,181,734; Stevens et al., 351,474; Hinckley, 135,988; Birch, 210,235; Michelin, 750,675; Mapes, 854,512; Moore, 2,184,358; Uecker, 2,203,114; and Athans, 1,679,017. All the said patents had been issued more than one year prior to the filing of the application which resulted in the patent in suit.”

The Court did not state in its Opinion (R. 13) nor is there any finding of fact that any prior art device:

- (a) was substantially the same in construction;
- (b) was substantially the same in mode of operation or function;
- (c) produced substantially the same results by substantially the same mode of operation.

The Trial Court's Opinion and findings are to the effect that if the individual parts of a patented structure can be separately found in prior art structures, no one of which was intended to function, nor capable of functioning like or producing the results of the patented structure, the result is unpatentable aggregation and not patentable invention. Appellants' contention on this appeal is that under the facts of this case the District Judge erred in so concluding.

THE ISSUES.

The single issue upon this appeal is the presence or absence of patentable invention in the patented structure, each individual mechanical part of which is found to be separately old in various prior art devices, *none of which are substantially like the patented structure in construction, function or in results produced*, and which patented structure resulted in an innovation in scaffolding within the scaffold industry.

The question on appeal is: May a patent on a meritorious and successful invention in a scaffold structure, which is new in construction and mode of operation, produces new results, and produced a new scaffold industry, be struck down as a matter of law as “not involving patentable invention” in the face of no other proof than when such new structure is dissected into its individual mechanical parts, each of such parts can be separately found in prior patents on structures substantially dissimilar in construction and function and not intended to, nor capable of obtaining the results of the patented structure?

Stated more broadly, the question on appeal is: Where a new device is created which is a new entity, with a new mode of operation and producing new or substantially improved results, is such a device an unpatentable aggregation and devoid of patentable invention because when dissected into its individual parts such parts are separately found in devices neither intended to nor capable of performing the function of the patented device?

SPECIFICATION OF ERRORS.

1. The District Court erred in finding as a fact (Finding VI) (R. 16) "that the invention claimed in the application for said patent had been described, prior to its filing date of September 15, 1947, in various printed publications, for more than one year prior to the patentee's application for patent." in that such finding of fact is not supported by the evidence.

2. The District Court erred in finding as a fact (Finding VII) (R. 16) that "The essential elements of the single claim of the patent in suit are disclosed in patents to: Countryman, 1,912,475; Taylor, 747,270; Burns, 1,181,734; Stevens et al., 351,474; Hinckley, 135,988; Birch, 210,235; Michelin, 750,675; Mapes, 854,512; Moore, 2,184,358; Uecker, 2,203,114; and Athans, 1,679,017." in that said Finding of Fact is not supported by the evidence.

3. The District Court erred in finding as a fact (Finding VIII) (R. 17): "Calipers embodying adjustments substantially like those in the patent in suit were well known for one year prior to the filing of the application which resulted in the patent in suit, as evidenced by Defendant's Exhibit O and the Stevens Patent No. 351,474." in that such finding is not supported by the evidence.

4. The District Court erred in finding as a fact (Finding IX) (R. 17): "The Patent Office, in issuing the patent in suit, failed to consider the most pertinent art, specifically the patents listed in Finding VII." in that said Finding of Fact is not supported by the evidence.

5. The District Court erred in finding as a fact (Finding X) (R. 17): "All of the elements of the claim in suit as aggregated by plaintiffs function as taught in the prior art

patents.” in that such finding is unsupported by and contrary to the evidence.

6. The District Court erred in finding as a fact (Finding XI) (R. 17): “Plaintiffs did not change, or bring to light, anything new in the functioning of these elements. The result of the claim in suit is aggregation.” in that such finding is unsupported by and contrary to the evidence.

7. The District Court erred in finding as a fact (Finding XIV) (R. 18): “an adjustable supporting leg having telescopic leg members, the inner leg member of which is threaded and the outer leg member carries a releasable split nut engaging with the threads of the inner leg member and a releasable slidable collar holding the parts of the split nut in gripping relation with the threaded inner leg member, was well known as evidenced by Countryman, 1,912,475.”

8. It was error for the District Court to attach any anticipatory significance to the eleven prior patents relied upon to show “lack of invention” where the structures of such prior patents are substantially different than the patented device in construction and function and results produced, and were not intended to nor capable of performing the functions of the patented device.

9. It was error for the District Court to conclude “lack of patentable invention” in the patented structure as a matter of law upon evidence which admittedly failed to show a structure constructed like or capable of performing the functions of the patented device, but merely disclosed that when the patented structure was dissected into its individual mechanical parts, that parts somewhat similar in construction but for different uses and purposes could be separately found in prior art structures of non-analogous nature.

10. It was error for the District Court in view of the state of the prior art as set forth in (9) above to deny patentable invention to the patented structure where the evidence disclosed that such a device not only was immediately and widely successful but established a new conception of scaffolding within the scaffolding industry, and which patented device was paid the tribute of prompt and precise copying by the appellee (one of the oldest and largest in the scaffolding business).

ARGUMENT.

(A) SUMMARY.

This case presents the picture of an outstandingly successful invention which filled a long-standing void in the scaffolding industry, which instead of being recognized as such, is held not to be a patentable invention by the fallacious hindsight reasoning that because its individual mechanical elements are separately old in devices not intended to nor capable of performing its functions or having its mode of operation, the embodiment of such elements into a new structure having a new construction and mode of operation and producing new results is obvious to those skilled in the art and is merely unpatentable aggregation. That the patented structure is new in construction and mode of operation and produces new and improved results is tacitly admitted, because the Trial Judge in his Opinion (R. 13) and in his Findings of Fact (R. 15) completely omitted *any statement or finding to the contrary*. Such omission speaks eloquently that any such statement or finding would be contrary to the evidence.

The long-standing void in the industry filled by the invention and the instantaneous and widespread commercial adoption of the patented structure and its precise copying by the appellee *because customers demanded it* (appellee is one of the oldest and largest in the scaffold art) emphasizes that the invention was unobvious to those expert in the field and must have involved the intangible, ingenious quality above and beyond the skill of the artisans of the industry.

The various elements of the patented claim all contribute to the ability of the structure to perform its new functions, to effect its new and improved results. This spells proper “combination” and not “aggregation” in law. Thus, notwithstanding the Court’s findings to the effect that each individual mechanical element may be specifically found³ in:

(the prior art patents)

Countryman (R. 306) : (an automobile jack)

Taylor (R. 316) : (a carpenter’s wood clamp)

Burns (R. 320) : (a temper screw used in a reciprocating oil-well drilling rig)

Stevens (R. 325) : (a machinist’s calipers or dividers)

Hinckley (R. 329) (a temper screw used in a reciprocating oil-well drilling rig)

Birch (R. 332) : (a gun-wiping ramrod)

³Finding VII (R. 16). The essential elements of the single claim of the patent in suit are disclosed in the patents to: Countryman, 1,912,475; Taylor, 747,270; Burns, 1,181,734; Stevens et al., 351,474; Hinckley, 135,988; Birch, 210,235; Michelin, 750,675; Mapes, 854,512; Moore, 2,184,358; Uecker, 2,203,114; and Athans, 1,679,017. All of the said patents had been issued more than one year prior to the filing of the application which resulted in the patent in suit.

Michelin (R. 335): (a tire valve cap)

Mapes (R. 340): (a temper screw used in a reciprocating oil-well drilling rig)

Moore (R. 344): (a tripod and leg)

Uecker (R. 302): (a scaffold which admitted does not function like or produce results like the patented one)

Athans (R. 293): (a service table)

The prior art patents relied upon by the District Judge to negative invention are not only for the most part of non-analogous character but fail to teach

(a) the construction of the patented device

(b) the functioning of the patented device

(c) a structure intended to or capable of performing the function or obtaining the results of the patented device.

In view of the substantial advance in the scaffolding art effected by the invention and its immediate success, the dissecting of the patented structure and the finding of the parts thereof separately in non-analogous prior devices not intended to and incapable of functioning or obtaining the results of the patented combination is insufficient basis upon which to conclude that the device is an unpatentable aggregation not involving patentable invention under the authorities of this Court of Appeals.

(B) THE FACTS.

(1) **The State of the Portable Scaffold Art at the Time of the Invention.**

The art to which the patent pertains is known generally as portable scaffold, but specifically as the rolling ladder

type of scaffolding best illustrated in Exhibit 14 at R. 274. This exhibit illustrates scaffold in which the precise structure shown in the patent in suit is embodied. Such scaffolds are supported on caster wheels and are made in vertical sections which are detachably superposed to a desired height. The entire scaffold can be rolled along from position to position as desired.

Ladder scaffolds had long been known but it is undisputed that their use was practically limited to interiors of buildings where flat floors were available as a supporting surface due to inherent inability of the scaffold to be adapted to meet the usual conditions of substantially non-level or uneven terrain or the presence of obstacles such as terraces, steps, curbs and the like around the exterior of buildings.

In this state of the art the inventor (appellant) Johnson and another conceived a collapsible scaffold section for such a ladder-type scaffold and obtained a patent therefor (patent at R. 268). He realized, however, that such scaffold would have the same limitations of use as the prior ones unless some means could be provided to make it practical for exterior work and eliminate the inherent shortcomings of prior scaffolds (R. 35-38). He recognized that the problem requiring solution was to construct such scaffold so it would have the following requisites (taken from Mr. Johnson's testimony R. 37 and 38):

“Mr. Mellin. Q. Mr. Johnson, what requisites were required for adjustability of the scaffold of the type you designed?

(a) For a portable scaffold there were a number of what I thought to be severe requirements. For one

thing, the scaffold leg or adjustable mechanism of whatever kind it was, had to be so fixed within the structure or the tubular outer leg of the scaffold that it would sustain sidewise loads as well as vertical loads, because in a portable scaffold which rolls by itself from position to position it normally is not fastened to a building or other structure which will take side loads, and therefore the scaffold had to—the leg had to be strong adjusted in any position so that sidewise it wouldn't buckle. That would be one very important characteristic of it.

(b) Another would be that the scaffold would have to take a vertical load in any position of the adjustment, because the entire weight of people or material on the scaffold would rest directly on the legs of the scaffold, and it being unattached to anything else, it would have to absorb all that load by itself.

(c) Another characteristic of the leg would have to be that it was firmly and positively locked within the structure of the scaffold, because you see moving it along from position to position implies rolling it over curbs or other holes in the ground or floor, and the leg couldn't by any means fall out, either by the fact that it wasn't frictionally tight in there or it was just loose in there; it had to be positively locked in there so when it was rolled over a hollow point in the floor or ground it wouldn't fall out.

(d) Another requirement was that it had to be able to be adjusted for a coarse or a large adjustment quickly and easily, because the inherent nature of the concept of the scaffold was that it had to be easily moved from position to position and each position had a different conformation of the ground or terrain, so that instead of something that had to be laboriously screwed or

otherwise adjusted up and down it had to have a rapid adjustment quick and easy over a considerable distance.

(e) I should say another characteristic that it requires for a portable concept of scaffold is that it have a fine adjustment so that after you made the coarse adjustment and you are up on top of a structure which is depending entirely upon itself for its stability and a fine adjustment had to be made so that it can have no wobble in the structure — if it were stationary or static form of scaffolding fastened to a wall, it wouldn't be so important then to have a fine adjustment so that it would be stable when it was adjusted."

Mr. Johnson, realizing that unless he could solve the problem his scaffold was of little commercial value, made a thorough search of the available art and could not find any mechanism answering the problem (R. 36, 38, 39). The invention of the scaffold section (not the invention in suit) was in 1945 yet it wasn't until after Mr. Johnson had solved the problem by the invention of the patent in suit that the appellant corporation was formed and scaffolds were commercially produced.

The embodiment of the patented structure in the scaffold gave the latter the necessary requisites to fill the need which existed and exterior portable rolling ladder-type scaffolding was born and became a valuable and substantial addition to the scaffold industry.

Mr. Johnson, commencing at R. 40, describes the patented structure and the manner in which it accomplishes its new functions and results. This also can be had from the patent (R. 232) or the exemplar of the device itself (Exhibit No. 7). It may be helpful to briefly discuss it here.

To form the patented structure⁴ a tubular supporting leg (1) is provided which is slit vertically from its lower end to form depending resilient fingers which are outwardly radially biased (2). A threaded relatively long inner leg (3) is telescoped into the outer tubular leg which has an unthreaded upper bearing portion (4) snugly sliding within the tubular leg. This upper bearing portion is much shorter than the threaded portion. The structure includes a segmental internally threaded nut (5), one part of which is welded to the interior of each resilient finger at its lowermost end. This segmental nut is normally held expanded out of engagement with the threaded inner leg by the biased resilient fingers, but when the nut is contracted by a sliding collar (6) on the outer leg, it is held in threaded engagement with the inner leg.

⁴To compare the structure with the patented claim element by element, we here point out how the elements of the patented structure appear in the claim:

(1) A scaffold supporting leg comprising a vertical tubular outer supporting leg member

(2) terminating at its lower end in a plurality of downwardly extending outwardly radially biased resilient fingers integral therewith,

(3) an inner member telescopically received within the outer member.

(4) said inner member having an upper cylindrical bearing portion engaging a complementary portion of said outer supporting leg member and having an externally threaded lower portion,

(5) a segmental internally threaded nut fixedly secured to said fingers for threaded engagement with the threaded portion of the inner member when the fingers are forced inwardly,

(6) a collar on the outer member movable relative to the nut to force the fingers inwardly to place the nut in threaded engagement with the threads of the inner member and to retain such engagement until the collar is moved relative to the nut to permit the fingers to move radially outwardly, the length of the threaded portion on the inner member being substantially greater than the length of the threaded portion of the nut.

In such condition the leg structure supports the complete vertical load on the threaded connection (requirement (a) above). It supports the side load or thrust by the threaded gripping of the inner leg by the nut and the engagement of the unthreaded bearing portion with the interior of the outer leg at a point spaced along the leg from the nut (requirements (a) and (b) above). These two points of gripping cooperate to resist side thrust and prevent wobble. Also, the unthreaded bearing portion cooperates with the fingers and nut segments in preventing the leg from being screwed out of the outer leg and toppling the scaffold, and also prevents the leg from falling out of the outer leg when rolled over a hole or deep depression and collapsing the scaffold (fulfilling requirement (c) above.)

By releasing the resilient fingers to expand the nut outwardly by sliding the collar out of engagement with the fingers, the inner ground-engaging leg can immediately be lowered its full length or be telescoped its full length upwardly into the outer tubular length, enabling an instantaneous coarse adjustment (in practice this is approximately three feet) (fulfilling requirement (d) above).

By turning the leg manually, the threaded engagement between the segmental nut and the threaded inner leg enables a fine or micrometer adjustment of the leg height to make certain all four scaffold legs properly engage the ground support to prevent wobbling such as a table does when one leg doesn't quite bear on the floor. In a tall scaffold this is of great importance (fulfilling requirement (e) above).

In use, the scaffold is erected at the exterior of the building to the proper height. Being but six feet long, it must

be frequently shifted when cleaning, painting or repairing a building, and the time required to shift the scaffold to its new position and set it for use is of high practical importance. When shifted, the patented scaffold can be immediately adapted to the terrain (no matter how rough or uneven) by releasing the inner legs one by one to engage the terrain and then reclamp the outer leg to the inner leg by contracting the spring fingers and nut by means of the sleeve support. Thus, if curbs, steps, or depressions of substantial height or depth are met, a minimum of time is expended to adjust the legs differently to the substantially different levels. Also, on steep grades this advantage is important. Once the coarse adjustment is made, a fine adjustment (a turn or two) is made to exactly plumb the scaffold to make it stable and safe, and the scaffold is ready for use.

It is important to point out (as above described) that the cooperation of the upper bearing portion of the inner leg and the nut (a) prevents wobbling of the scaffold; (b) keeps the inner leg from dropping out of the outer leg when and if it passes over a hole or depression when the scaffold is moved from position to position; and (c) keeps the inner leg from being unscrewed out of the outer leg when finely adjusting to plumb the scaffold.

The reasons that prior rolling scaffolds⁵ were unsuited for and unused in exterior work were (a) where substantially different elevations were met, the legs each had to be slowly and laboriously adjusted vertically by turning a nut on the threaded inner leg to raise or lower it a small fraction of an inch per revolution. This slow process required

⁵The patent to Uecker (R. 302) is an accurate exemplar of the prior art structures. An exact physical exemplar (one leg only) is in evidence as Plaintiffs' Exhibit 12.

so much time as to make the scaffold unfeasible for exterior work; (b) in addition, as will be seen from Fig. 2 of the Uecker patent (R. 302), if it were fitted with a caster and the scaffold rolled to align one leg with a hole or deep depression, the inner leg 14, its nut 20-27, and the upper slide 15 would drop out of the scaffold leg. This is clearly apparent from an examination of the physical prior leg (Exhibit 12).

Clearly, from the evidence as outlined above, the patented structure has new functions, produces new results, and supplied an unfilled need in the scaffold art by providing a stable, efficient and usable rolling ladder-type scaffold for exterior work.

(2) The Appellee's Tribute to the Invention.

Appellee (defendant), for more than 10 years (R. 178) prior to the time appellants' patented scaffold was produced and widely successful in the industry, was manufacturing and selling the old type of scaffold above discussed with legs as exemplified in Exhibit 12 and Uecker patent (Exhibit E, R. 302). Immediately the patented structure was introduced and demanded by the trade, appellee precisely copied the patented structure. That the copying was precise, even as to details of dimensions and threads, is shown by the testimony of Mr. Johnson at R. 59. The appellee's reason for so copying the patented structure was that customers demanded it (appellee so admitted R. 182-183).

It seems convincing evidence that the invention was not obvious to those skilled in the art, when it is considered that it was certainly not obvious to appellee during the ten years it made the old type incapable of the functions of the patented type. As one Court aptly put it (*Diamond Rubber Co.*

v. Consolidated Rubber Tire Company, 220 U.S. 426, 55 L. Ed. 527) :

“We see the strength of the concession to its (the patent’s) advance beyond the prior art and its novelty and utility by the rubber company’s imitation of it.”

* * * * *

“It gives the tribute of its praise to the prior art; it gives the Grant tire the tribute of its imitation.”

(3) The Immediate and Widespread Success of the Invention.

Appellants’ patent in providing the first successful solution to the problem of rolling ladder-type scaffold for exterior use was an innovation and added a new concept of scaffold to the industry. This is made amply apparent by its immediate and widespread acceptance (as well as adoption by appellee who was long in the field).

This novel concept was quickly adopted as is witnessed by the fact that a new company (appellant) was formed in 1948, between which time and the commencing of this suit in 1952 had made and sold some 20,000 base scaffolding units embodying over 79,000 of the patented structures. This quick adoption of the novel concept by industry as a standard certainly belies a hindsight finding that it was “obvious”.

While the success of the invention cannot be substituted for invention, it is a factor which has weight in considering the presence or absence of patentable invention, as this Court has many times stated. (See *Pointer v. Six Wheel Corporation* (C.A.9), 117 F. 2d 153.)

(4) The Prior Art Patents Relied Upon Are in Fact Insufficient to Negative Invention and Are Insufficient Evidence Upon Which to Base Findings and Conclusions of Lack of Patentable Invention in the Patent in Suit (Specification of Errors 1, 2, 3, 5, 6, 7, 8, 9 and 10).

Before individually discussing the prior art patents relied upon to negative invention in the patent in suit, we emphasize that the District Court *did not state in its Memorandum Opinion R. 13 or make any finding of fact* that any prior art device was substantially the same as the patented device in

- (1) construction
- (2) function or mode of operation
- (3) producing substantially the same results.

The District Court merely found that the various elements were separately old in various prior structures (for the most part non-analogous structures). Findings that the invention lacked a new construction, new functions and mode of operation and failed to produce new or expected results were not made and could not possibly be supported by the evidence.

Appellee's own expert, Mr. White (a practicing patent lawyer), who had no practical experience in the scaffolding art except what he gained in preparing to testify, admittedly could not stretch the prior patents sufficiently to effectively meet the invention involved.

On cross-examination Mr. White was asked (R. 170-171):

“Q. By the way, Mr. White, of all of these patents that you have brought before us and explained to the jury, which one in particular do you think is most like the device of the patent in suit in construction and in mode of operation?”

A. So far as structure is concerned, the Michelin patent shows all the elements of the clutch mechanism; and so far as operation as a leg is concerned on the general aspects, as I stated before, the Athans patent shows the general adjustment with a different clutch mechanism. Countryman on the jack shows every element of the combination.”

Inasmuch as appellee’s own “expert” considered those three patents to be the closest to the invention, we will discuss them first.

Michelin Patent No. 750,675, Exhibit L, R. 334.

This patent shows a split nut for firmly holding an automotive tire stem firmly in place relative to the auto wheel. It enables quick positioning of the nut over the traditionally long tire stem against the rim and then tightening the nut to make a firm clamp.

Appellee’s Mr. White admitted (R. 159) that no suggestion of a scaffold supporting leg was found in that patent or that the tire stem could act as a supporting leg. Further, he admitted that there was no suggestion in this patent of the features of the patented device which prevented wobbling, unthreading or accidental removal of the inner leg of a scaffold from the outer (R. 159). In fact, he went so far as to admit that the only pertinency of this patent was that it merely disclosed an application of the old split nut (R. 171).

This non-analogous patent disclosure does not show the patented structure nor any of its functions or results, nor the functioning of any of its elements, and is insufficient evidence upon which to base the contested findings.⁶

⁶Findings VI and VII (Specification of Errors Nos. 1 and 2).

Athans Patent No. 1,679,017, Exhibit D, R. 292.

This is a table leg and appellee's expert, Mr. White, freely admitted (a) that the Athans device has no mechanical connection between the parts of the leg (R. 166); (b) that Athans has no threaded or similar adjustment between the leg parts (R. 166); (c) that it does not have the functions of the patented device (R. 166); and (d) that the Athans device was unfitted for a scaffold leg and he would not so use it (R. 166).

In view of appellee's own appraisal of this patent, it falls miserably short of anticipating the patented invention. It not only does not bear any similarity in construction to the patented device but has none of its functions (except it telescopes) or produces none of its results. Except that the lower end of the outer member is slit so it may be contracted, the Athans device has no "element" structurally or functionally like any element in the patented structure. Yet this is by its own appraisal appellee's best evidence upon which to base a finding of lack of novelty in the construction of the patent in suit. This patent is obviously insufficient evidence to support the findings of fact contested.⁷

Countryman Patent No. 1,912,475, Exhibit F, R. 305.

This device is an automobile or like jack. It has a work-engaging top member 26 (referring to the drawings R. 306) fixed on a tube 25 which telescopes over the screw jack member 1. Diametrically opposite pawls 28 (referring to Fig. 6) are pivoted to the lower end of the tube to engage

⁷Specification of Errors Nos. 1 and 2—relating to Findings of Fact Nos. VI and VII.

the threads of the member 1 and lock the tube to the screw. A ring 31 is provided to hold the locking pawls engaged with the screw.

This device neither shows the construction nor the functions of the patented device. For example, appellee's expert, Mr. White, admitted that Countryman required gears operating a separate captive nut to effect a fine adjustment (R. 167). He also admitted that the threaded member could be threaded out of the pivotal parts of the latch mechanism (R. 168) and further that the device is free to wobble in use (R. 168). Mr. White freely admitted (R. 167) that the Countryman device does not have the same mode of operation or produce the same results as the patented device. With these admissions, it cannot be said that Countryman is evidence of lack of novelty in the patented entity or the essential elements thereof as found in the contested findings.⁸

This patent falls far short of being sufficient to justify Findings VII and XIV.

Birch Patent No. 210,235, Exhibit K, R. 331.

This patent shows a quick detachable connection for a gun wiper. Appellee's witness, Mr. White, admitted it had no ability for adjustment and was offered merely to show another application of a split nut (R. 172). This patent consequently is not only of no aid to appellee in showing lack of invention in the patent in suit, but does not as found⁹ contain any of the elements of the patented claim with their function as found as a fact.⁹

⁸Contested—Specification of Errors Nos. 1, 2 and 7.

⁹Contested Finding VII—Specification of Errors No. 2.

Burns Patent No. 1,181,734, Exhibit H, R. 319;
 Hinckley Patent No. 135,988, Exhibit J, R. 328;
 Mapes Patent No. 854,512, Exhibit M, R. 339.

These patents all show different conceptions of temper screws used in drilling wells. These devices have nothing in common in function or result with the patented structure. They all employ a split nut travelling back and forth on a threaded rod. None of them shows (a) the telescopic feature of the patented device and (b) the forming of a scaffold leg with spring fingers and the integral nut parts thereon which cooperate with a caster leg to enable rapid and fine adjustment, prevent accidental displacement or wobble between the leg parts. In fact, no suggestion of the patented construction, mode of operation, or results is found in these patents. Yet these patents were included as containing essential elements of the patented structure in contested Finding VII.^{9a}

Taylor Patent No. 747,270, Exhibit G, R. 315.

This patent discloses a carpenter's wood clamp. Appellee's witness, Mr. White, admitted it merely discloses another application of a split nut on a threaded bolt (R. 168) in which the nut parts are urged outward by leaf springs and urged inward by a collar. Appellee made no contention, other than above stated, that this patent disclosed a device having the mode of operation or produced the results of the patented device at bar.

Despite this, the contested finding¹⁰ is to the effect that essential elements of the patented device with their function are present in this prior device.

^{9a}Contested Finding VII—Specification of Errors No. 2.

¹⁰Finding VII—Specification of Errors No. 2.

Stevens Patent No. 351,474, Exhibit I, R. 324.

The Stevens patent discloses an adjustable nut for a pair of machinist's calipers or dividers (R. 140). Mr. White admitted that the Stevens patent merely shows another application and use of a split nut (R. 170). Except that it employs a split nut in another capacity, this prior patent bears no relationship to the patented structure.¹¹

Moore Patent No. 2,184,358, Exhibit N, R. 343.

The only thing that this patent (on a tripod leg) has in common with the patented device is that the upper end of the inner member in each is unthreaded. No other similarity other than broadly speaking each includes telescopic members. The above is based on appellee's Mr. White's testimony at R. 175-176.

This device does not disclose the cooperating essential elements of the patented device or their function as found in the contested findings.¹²

Uecker Patent No. 2,203,114, Exhibit E, R. 301.

This patent represents the prior device which appellee abandoned in favor of the patented device. Appellee's expert, Mr. White, in substance admitted that the Uecker device does not have the mode of operation of the patented device (R. 166) and it does not have the ability to be rapidly adjusted (R. 166). In fact, the Uecker device was the appel-

¹¹Despite this the finding contested (Finding VIII—Specification of Errors No. 3) states:

“Calipers embodying adjustments substantially like those in the patent in suit were well known for one year prior to the filing of the application which resulted in the patent in suit, as evidenced by Defendant's Exhibit O and the Stevens Patent No. 351,474.”

¹²Finding VII—Specification of Errors No. 2.

lee's prior commercial device, Exhibit 12, which according to the evidence was a failure and was replaced by the patented device.

Admittedly not having the mode of operation of the patented device nor capable of producing its results, the Uecker patent fails to indicate lack of invention in the device at bar or include its essential elements as found.¹³

Uecker Patent No. 2,043,498, R. 250.

This patent merely shows a scaffold leg having the caster leg threaded into it. This device has none of the functions of the patented device except it can be adjusted vertically in minute steps. This is the device of the character formerly used by appellee and abandoned in favor of the patented device. Not being capable of the functions of the patented device nor able to produce the results of the patented device, this prior art disclosure is of no importance in showing lack of invention in the patented device.

Just how the Trial Judge arrived at the conclusion that the various pieces found separately in eleven prior patents (none having the functions served by them in the patented structure and embodied in devices not intended to nor capable of functioning like or obtaining the results of the patented structure), could be obviously assembled to form the patented structure with its functions was not explained by the Court in its Opinion or in its findings. We urge that the Trial Court fell into the error of believing that if the physical counterparts of the various pieces are found in different prior structures (without regard to their function), that

¹³Finding VII—Specification of Errors No. 2.

combining such old parts into a new entity having new functions and results was “unpatentable aggregation.”

This is not the rule followed by this Court¹⁴ which is well stated in *Pointer v. Six Wheel Corporation*, 177 F. 2d 153 (C.A.9, 1949). The Court, in finding invention and sustaining the patent, stated as follows:

“* * * invention cannot be defeated merely by showing that, in one form or another, each element was known or used before. *Hailes v. Van Wormer*, 1875, 20 Wall., 353, 22 L. Ed. 241, *Bassick Mfg. Co. v. R. M. Hollingshead Co.*, 1936, 298 U.S. 415, 425, 56 S. Ct. 787, 80 L. Ed. 1251; *Kings County Raisin & Fruit Co. v. U. S. Consolidated Seeded Raisin Co.*, 9 Cir., 1910, 182 F. 59; *Stebler v. Riverside Heights Orange Growers Ass'n*, 9 Cir., 205 F. 735; *Skinner Bros. Belting Co. v. Oil Well Improvements Co.*, 10 Cir., 1931, 54 F. 2d 896, 898; *Haliburton Oil Well Cementing Co. v. Walker*, 9 Cir., 1944, 146 F. 2d 817, 819.”

(C) THE APPLICATION OF THE LEADING AUTHORITIES DEFINING “PATENTABLE INVENTION” TO THE FACTS OF THE CASE AT BAR.

From the foregoing discussion of the facts and the prior art, the patent in suit meets the test of invention set out in the A. & P. case¹⁵ and the recent cases¹⁶ in this Court.

¹⁴Additional authorities of this Court on the point are discussed later in this brief.

¹⁵*Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., et al.*, 71 S.Ct. 127, 340 U.S. 147 (1950).

¹⁶*Kwikset Locks, Inc. v. Hillgren*, 210 F. 2d 483 (C.A. 9, 1954);

Air Devices, Inc. v. Air Factors, Inc., et al., 210 F. 481 (C.A. 9, 1954);

The appellee did not contend but tacitly agreed that no prior art structure has been found having the construction and functions of the patented device or producing its results. The Trial Court also so agreed as follows (R. 214):

“Mr. Mellin. That is right, Your Honor. Where in the prior art does the concept of the finding that in a scaffold leg you could make the bottom part of the leg in a fashion that has been done, adding and making use of that function for a quick and a small adjustment at the same time preventing swaying and preventing accidental tipping over? Where is it in the prior art? It isn't there.

The Court. I agree with you it isn't there. The mere fact that something has considerable value and is utilitarian, it is useful and so forth, it is created, doesn't necessarily make it patentable.”

Thus, the fact that the device is a new entity having new functions, producing new results and resulting in a new conception of scaffolding being added to that industry, coupled

Patterson-Ballagh Corp., et al. v. Moss, et al., 201 F. 2d 403 (C.A. 9, 1953);

Pointer v. Six Wheel Corporation, 177 F. 2d 153 (C.A. 9, 1949);

Oxnard Cannery, Inc., et al. v. Bradley, 194 F. 2d 655 (C.A. 9, 1952);

Refrigeration Engineering, Inc. v. York Corporation, 168 F. 2d 896 (C.A. 9, 1948);

Faulkner v. Gibbs, 170 F. 2d 34 (C.A. 9, 1948);

Bianchi, et al. v. Barili, 168 F. 2d 793 (C.A. 9, 1948);

Page, et al. v. Myers, 155 F. 2d 57 (C.A. 9, 1946);

Ralph N. Brodie Co., et al. v. Hydraulic Press Mfg. Co., 151 F. 2d 91 (C.A. 9, 1945);

Halliburton Oil Well Cementing Co. v. Walker, et al., 146 F. 2d 817 (C.A. 9, 1944);

Stuart Oxygen Co., Limited v. Josephian, 162 F. 2d 857 (C.A. 9, 1947);

Dick E. Stearns, et al. v. Tinker & Rasor, et al., 220 F. 2d 49.

with the fact that it met with immediate and widespread success of the invention and was *promptly copied by appellee*, definitely shows that the patented structure meets the test of patentable invention laid down by our Supreme Court and this Court.

In the patented device the conjunction or concert of known elements has contributed something; the whole has exceeded the sum of its parts. This is the test of invention set out by Mr. Justice Jackson in the A. & P. case as follows:

“* * * The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable * * *.”

The different mode of operation of the patented device springs from the conjunction or concert of the different functions performed by the known elements and resulted in the industry adopting the invention.

In addition, the elements of the patented device when considered individually, have been shown to perform different or additional functions in the new combination than the functions they performed in their old surroundings. This is another test stated by Justice Jackson in the A. & P. case:

“* * * A patent for a combination which only unites old elements with no change in their respective functions, such as presented here, obviously withdraws what already is known into the field of its monopoly * * *.”

This difference in function of the components of the patented device appears from a brief comparison of the undisputed character of the prior art.

While the Athans (R. 293), Moore, (R. 344), Uecker (R. 302) patents show telescopic legs (Athans for a table; Moore for a tripod; Uecker for a scaffold), none of these patents had the weight-sustaining, non-wobbling, instantly adjustable over a wide range and finely adjustable features of the patented device. This was, as above pointed out, admitted by appellee. Indeed, those prior devices were not intended to nor capable of the functions of the patented device and the results it produced.

The Michelin (R. 355) (a tire stem nut or cap), the Countryman (R. 306) (an automobile jack), Taylor (R. 316) (a carpenter's wood clamp), Stevens (R. 325) (a machinists' calipers), Mapes (R. 340), Hinckley (R. 329), Burns (R. 320) (all temper screws for oil-well drilling rigs), Birch (R. 332) (a gun ramrod) patents, merely show various forms of a split nut in different assemblages for other purposes and uses and not for functioning as weight-sustaining, vertically stable, instantaneously adjustable over a wide range and finely adjustable leg for a rolling scaffold. Undisputedly, such prior devices were not intended to nor are they capable of the patented use.

It seems convincingly clear that the patented device, when considered in the light of these uncontroverted facts, operates in a manner theretofore unknown in scaffolding due to the conjunction or concert of action of known elements so that the whole has exceeded the sum of its parts, thus fully meeting the test of invention of the A. & P. case.

The A. & P. case has had much discussion by the courts, we think principally due to the minority opinion. This minority opinion was based primarily upon the thought that the grocery store rack was a gadget of the same ilk as

a rubber eraser on a pencil, a clay door knob instead of a metal door knob, a paper collar instead of a cloth collar, and the like. This kind of reasoning is inapplicable to the patented invention which obviously is not a gadget.

The test of invention of the A. & P. case, when carefully considered, boils down to another frequently applied test of invention; that is, obviousness. In other words, of a combination of old elements, due to the concert of action of those elements, contributes a result which exceeds the sum of its parts, then the invention can well be said to be an unobvious one. This is the test adopted by Congress in the new PATENT STATUTE effective January 1st, 1953, Section 103, Title 35, U.S.C. that a patent may not be obtained —

“* * * if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole *would have been obvious, at the time the invention was made, to a person having ordinary skill in the art to which said subject matter pertains.*” (Emphasis added.)

It is significant that this language is just a different way of stating the test of the A. & P. case and, further, is a re-statement of the test of invention set out in the landmark decision of the Supreme Court in *C. & A. Potts & Co. v. Frank F. Creager, et al.*, 155 U.S. 597; 39 L. Ed. 275. In that decision, the Court admonished against the very pitfall into which the Trial Court fell, warning the inexperienced person against the application of hindsight to determine what was obvious to an industry instead of viewing the activities of the industry and those skilled in the industry to see what was obvious. In this case it was stated:

“* * * The apparent simplicity of a new device often leads an inexperienced person to think that it would

have occurred to anyone familiar with the subject; but the decisive answer is that with dozens and perhaps hundreds of others laboring in the same field, it had never occurred to anyone before. The practiced eye of an ordinary mechanic may be safely trusted to see what ought to be apparent to everyone.”

Under the facts of the case at bar, this Court has uniformly sustained patents. Among the cases so holding are the following:

Refrigeration Engineering, Inc. v. York Corporation,
168 F. 2d 896 (C.A.9, 1948).

“*Defendant concedes that all elements of the claimed invention were old and well known to the refrigeration art prior to such invention. Its position is that McAdam’s arrangement and assembly of these old elements has created a new combination which unites these old elements in such manner as to provide or create a new entity divorced from any one element; that in the ‘composite’, or union of all its elements, the effect produced by their joint action is a new, final and combined result in the art of refrigeration never produced before; and that this combination introduced a new function in an old art by producing a new, useful and final effect, result and method which performs an old function in the art of refrigeration in a new and more advantageous way.*

“An expert witness for defendant testified that: ‘*In this combination you have a new entity*¹⁵ which brings out a different result and a combined result of all of those elements to produce the final result which makes the thing successful.’ And again, ‘Each of the elements is old but in being brought into this particular com-

¹⁵Court’s emphasis.

ination it has provided a new entity which is divorced from any one element and is the composite of all of those elements* which produced a new result which has never been produced before.' ”

The present device fully meets the “new entity” rule of the above case and is patentable.

Pointer v. Six Wheel Corporation, 177 F. 2d 153 (C.A. 9, 1949).

The issue in this case was the question of invention. The device involved was a tandem axle arrangement for automotive trucks. The new idea involved was to insert a universal joint (old element in the the automotive art) between the rocker arm (old element in the art) and the added axle (old element in the art) of the tandem axle assembly (old assembly in the art).

The Court, in stating the invention, stated as follows:

“He solved the problem by interposing a universal joint between the rocker arm and the added axle of the tandem axle assembly. The second axle has freedom of movement. It may assume an irregular position or angle to the driven axle. The universal joints prevent the strain on the added axle.

“In brief, when the vehicle passes over a rough road, the movements of the wheels conform to the contour of the road, the wheels moving towards one another or away from one another. At the same time, as the wheels always revolve in the direction of the travel, they track.”

We emphasize here that *there was no new element per se involved in this combination*, but merely old elements assembled to meet the tandem axle problem.

The Court, in finding invention and sustaining the patent, stated as follows:

“* * * invention cannot be defeated merely by showing that, in one form or another, each element was known or used before. *Hailes v. Van Wormer*, 1875, 20 Wall., 353, 22 L. Ed. 241, *Bassick Mfg. Co. v. R. M. Hollingshead Co.*, 1936, 298 U.S. 415, 425, 56 S. Ct. 787, 80 L. Ed. 1251; *Kings County Raisin & Fruit Co. v. U. S. Consolidated Seeded Raisin Co.*, 9 Cir., 1910, 182 F. 59; *Stebler v. Riverside Heights Orange Growers Ass’n*, 9 Cir., 205 F. 735; *Skinner Bros. Belting Co. v. Oil Well Improvements Co.*, 10 Cir., 1931, 54 F. 2d 896, 898; *Haliburton Oil Well Cementing Co. v. Walker*, 9 Cir., 1944, 146 F. 2d 817, 819.

“The question is: *Did anyone before think of combining them in this manner in order to achieve the particular unitary result, — a new function? If not, there is invention.*¹⁸ *Keystone Mfg. Co. v. Adams*, 1894, 151 U.S. 193, 14 S. Ct. 295, 38 L. Ed. 103; *Faries Mfg. Co. v. George W. Brown & Co.*, 7 Cir., 1902, 121 F. 547; *Lincoln Engineering Co. of Illinois v. Stewart-Warner Corp.*, 1938, 303 U.S. 545, 549, 58 S. Ct. 662, 82 L. Ed. 1008; *Lincoln Stores v. Nashua Mfg. Co.*, 1 Circ., 1947, 157 F. 2d 154, 162.

“At times, the result is accomplished by means which seem simple afterwards. * * *”

Patterson-Ballagh Corp., et al. v. Moss, et al., F. 2d 403 (C.A. 9, 1953).

The invention involved was a rotating spool designed to alleviate lateral whip of the drilling line between the crown block and the cylinder drum.

¹⁸All emphasis ours unless otherwise noted.

It appears from the decision that the main change over the prior art was in hanging the spooler from an eye at the top of the spooler rather than from the middle of the spooler. See the following from that opinion:

“If hanging a spooler from an eye at the top was obvious to one skilled in the art, including a practical man of the oil fields, we do not understand why appellants manufactured their spoolers with an eye in the middle from July 1936 to July 1937. There are other unanswered questions. If appellants finally changed the eye on their spoolers from the middle to the top in July 1937 in response to suggestions received from men working in the oil fields, as they allege, why were these men not brought forward to testify? If these suggestions were received in 1936 and 1937, why were they not incorporated in a patent application for a spooler filed by appellants in December 1936, and the Reed patent application filed in May 1937?”

In finding invention, the Court stated as follows:

“It is quite apparent that simplicity alone will not preclude invention. Hindsight tends to color the seeming obviousness of that which in fact is true contribution to prior art. ‘Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skilful attention.’ *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 1911, 220 U.S. 428, 435, 31 S. Ct. 444, 447, 55 L. Ed. 527.”

Bianchi, et al v. Barili, 168 F. 2d 793 (C.A. 9, 1948).

The patent was held to disclose invention in a ravioli machine which, like the invention at bar, used old mechani-

cal principles but had new functions and produced new results. The Court stated as follows:

“Barili’s patent discloses a ‘combination’ device. For example, molds were known to the prior art (Evans); so were rollers between which alimentary paste was to be pressed (Holmes, Evans, and Tommasini); so were cutters or ‘teeth’ (Evans, Oleri and Tommasini); and so were hoppers containing stuffing (Holmes and Tommasini). Barili’s contribution to the art was to combine these and other elements in such a form as to turn out ravioli in a different manner and with greater rapidity.

“Such advance involves more than mere technical skill of which, in the language of the books, any one learned in the art might be capable. Barili’s contribution amounts to actual invention: not invention, perhaps, of the highest order, but an invention that is patentable.

“For one thing, Barili’s machine is superior in two respects over the devices invented by Holmes and Tommasini, his closest rivals. Unlike Holmes, Barili provides wide flanges or margins for his ravioli, so that they may be tightly sealed and thus prevent the stuffing from leaking. Unlike Tommasini, Barili offers an invention capable of turning out not one but twelve ravioli with every synchronous rotation of the two form and cutting rollers.”

Stuart Oxygen Co., Limited v. Josephian, 162 F. 2d 857 (C.A. 9, 1947).

The invention here was manifolding a group of steel gas bottles (tanks) together on a flat plate having a disk on its underside to enable rolling of the tanks (barrellike) when tilted.

The Court stated the invention as follows :

“* * * They cast about for some way to deliver a number of tanks manifolded together so that less handling would be required. But to fasten many tanks together made the unit so heavy that it could not be conveniently handled — particularly so, since, in many instances, the valve fittings had to connect exactly with the consumer’s pipe lines. Moreover, other considerations made it imperative that the multiple unit, when constructed, could be handled manually by a single man.

“Appellee then invented and patented a device whereby a number of tanks were mounted upon a plate (see the illustration) manifolded together so that the gas from all the tanks could be drawn from a single connection, and the entire unit so balanced upon what appellee calls a ‘track’ that it could be handled manually by a single workman. * * *”

* * * * *

“As we construe appellee’s patent, his invention is a device to enable one man to handle manually, by rolling along on the ‘track’, a large number of cylindrical tanks of great weight, with comparative safety from overturning. * * *”

The invention above merely used very simple mechanical elements, but it produced very practical results.

Faulkner v. Gibbs, 170 F. 2d 34 (C.A. 9, 1948).

This patent covered a pin-ball game. The Court, in holding the patent valid, said:

“Appellee’s device is concededly a combination of old elements but he claims that it is a new and novel entity producing a new result never produced before. He sought the relief usually demanded in infringement cases.”

* * * * *

“In essence appellee’s patented game device is an assembly or combination comprising a plurality of electrically interconnected game units each of which units has the general outward appearance of the well known pin-ball machine. Each unit is operated by a separate player who competes with players operating the other units in the multiple assembly. See *Gibbs v. T.Z.R. Amusement Corporation*, reported in D.C., 14 F. Supp. 957, a case involving the Gibbs patent. (All of the claims of the patent are there set forth and in the interest of brevity they are not repeated here.)”

When dissected, each element used in the game was old but the new entity created was an invention. The latter is true in the case at bar.

Page, et al. v. Myers, 155 F. 2d 57 (C.A. 9, 1946).

The question here was whether or not a reassembly of old parts accomplishing a new purpose involved invention. The Court held it did and the patent was valid. The Court stated as follows:

“The pivotally mounted bunks were known prior to the Myers patent, the use of rub plates at some distance from the center pin was old, and the use of forked or straddle mountings on other dual axle vehicles was old in the art.

“The only question here is whether the combination constituted patentable novelty.”

As to the matter of invention, the Court stated as follows:

“In the Webster Loom Case, the *Loom Co. v. Higgins*, 105 U.S. 580, 26 L. Ed. 1177, the Supreme Court declared a patent for an improved loom for weaving pile fabrics valid, setting forth the test for distinguishing patentable combination and mere aggregation. The

Webster loom was old, every part was known to the loom manufacturer and the weaver. The court applied the test that if the new combination of old elements produced a new and beneficial result never attained before, it was evidence of invention. The Webster loom produced 50 yards where the former looms had produced 40 yards, and the court said the combination by which this was effected, even if those elements were separately known before, was invention sufficient to form the basis of a patent.

“In *Wire Tie Machine Co. v. Pacific Box Corporation*, 9 Cir., 102 F. 2d 543, 552, this court upheld a patent for a fully automatic wire binding machine that tied a flat knot, applying the test of the Webster Loom case. Also see *Levin v. Coe*, 76 U.S. App. D.C. 347, 132 F. 2d 589.”

Here is another example where the elements, when dissected, were each separately old, but modification of them and a new combination of them was patentable. Using the same test, the patent in suit is certainly valid.

In its latest decision on the point (*Dick E. Stearns, et al. v. Tinker & Rasor, et al.*, 220 F. 2d 49) this Court said relative to facts somewhat paralleling those in the case at bar:

“* * * From what has been said hereinbefore of the history of the holiday detector art, a reading of these claims raises the inquiry whether the Stearns patent is for a combination of old elements; and, indeed, appellants concede that the elements are old. * * *”

* * * * *

“Without the support of the subsidiary findings which we hold are clearly erroneous, the finding of the court below that the combination of old elements in the Stearns patent does not amount to patentable invention because the elements thereof do not cooperate in

any new way or contribute any new and unexpected result must also fall. The elements of the Stearns combination do functionally operate differently in the combination than they did in their old surroundings. * * *

And this different coaction of the elements produces a new and useful result, viz.: The detection of holidays in a more facile and efficient way *Willard v. Union Tool Co.*, 9 Cir., 253 F. 48, 54; *Long v. Dick*, D.C. Cal., 38 F. Supp. 214, 220; *Application of Ostermann*, 179 F. 2d 1010, 1014, 37 C.C.P.A., Patents, 891, *Imperial Brass Mfg. Co. v. Bonney Forge & Tool Works, Inc.*, D.C. Pa., 38 F. Supp. 829, 830; 69 C.J.S., Patents, § 68, page 303; 40 Am. Jur., Sec. 19, p. 543.”

See also:

Pacific Contact Laboratories, Inc., et al. v. Solex Laboratories, Inc., 209 F. 2d 529 (C.A. 9, 1953);

Cutter Laboratories, Inc. v. Lyophile-Cryochem Corporation, 179 F. 2d 80 C.A. 9, 1949);

Ralph N. Brodie Co., et al. v. Hydraulic Press Mfg. Co., 151 F. 2d 91 (C.A. 9, 1945);

Halliburton Oil Well Cementing Co. v. Walker, et al., 146 F. 2d 817 (C.A. 9, 1944).

The *Kwikset Locks* case¹⁹ is not authority for “lack of patentable invention” under the facts of the case at bar. In the *Kwikset Lock* case, not only was the “deadlatch mechanism to be found in the prior art” but it was also shown to have been applied to direct action rocker-type locks. All the patentee did was to apply it to a reverse action rocker-type lock. The Court, after stating that the “principle upon which the deadlatching mechanism operates is no different if used in conjunction with a direction action

¹⁹*Kwikset Locks, Inc. v. Hillgren*, 210 F. 2d 483 (C.A. 9, 1954).

on reverse rocker-type lock'', held such a minor advance to lack patentable invention.

The facts of that case and the case at bar are fundamentally different because in the *Kwikset Locks* case there was no entirely new entity having new functions and producing new or different results.

Obviously, in the case at bar the Trial Court based its decision upon an erroneous concept that patentable invention cannot reside in a new entity when the mechanical parts thereof can be separately found in analogous and non-analogous prior devices despite the fact that the latter do not and are not intended to nor capable of accomplishing either the function or results of the new entity. In other words, the District Court by the use of hindsight not only of necessity had to reconstruct the various parts of the new entity separately found in the art and give them new and additional functions, but had to assemble them into a new assemblage in the light of the invention as a basis for holding lack of novelty and patentable invention. This method of finding lack of invention is improper in that this Court has held that under circumstances similar to those of the case at bar, prior patents "cannot be reconstructed in the light of the invention of the patent in suit, and then used as a part of the prior art." *Payne Furnace & Supply Co. v. Williams-Wallace Co.*, C.A. 9, 1941, 117 F. 2d 823, 826; *Bianchi v. Barili*, C.A. 9, 1948, 168 F. 2d 793, 796; *Brown & Sharp Mfg. Co. v. Kar Engineering Co.*, C.A. 1, 1946, 154 F. 2d 48, 53.

Clearly, from the above, there is no prior disclosure containing the essential elements and functions of the patented structure. The patented structure—

- (a) is substantially novel in construction
- (b) has substantially new functions and abilities
- (c) obtains new or at very least vastly improved results.

This, combined with the substantial step forward it accomplished in the art, spells patentable invention.

(D) THE DEVICE OF THE PATENT IN SUIT IS NOT AN "AGGREGATION" AS THAT TERM IS USED IN PATENT LAW.

An unpatentable aggregation is taking several old things and joining them together, each separately performing its old function without modifying the function of the remainder so that the result is merely the sum of the separate operations. An excellent example is set forth in the following case:

Lane-Wells Co. v. M. O. Johnston Oil Field Service Corporation, 181 F. 2d 707 (C.A. 9, 1950).

In this case the Court described the patented device as follows:

"It is conceded that all of the separate elements of the tool described in the patent claims, the packer, the gun mechanism for perforating the well casing and the sample receiver, were old and well known in the art at the time Lane first made his formation tester. * * *"

The separate elements were formerly separately run into the well and all that was done in the patent was to connect these three old elements together so they could be run in the well at one time and then operate in succession precisely as they had been operated separately prior to that time. There was a great saving in drilling time but no other advantage.

The Court, in holding the claims invalid on the grounds of aggregation rather than combination, stated as follows:

“It is also our conclusion that the Lane device constituted only a bringing together in juxtaposition of old and well known elements; that whatever advantageous results were thus accomplished were not different in character from the aggregate results of the old tools; and that in the Lane device there was lacking that mutuality of action, that joint, cooperative functioning of the old elements to produce a new and different result, which is essential to raise a mere aggregation to the level of a patentable combination.”

In that case neither the parts nor their functions were changed or modified by aggregating them and no new result was produced. Certainly, in the case at bar there is complete mutuality of action and joint cooperative function to produce the new unitary result.

(E) THERE IS NO ISSUE OF INFRINGEMENT.

As before set out in this brief, there is no issue of infringement because the only evidence is that the accused device is a precise copy of the patented structure as described and claimed in the patent in suit. The District Judge recognized this by saying (R. 206):

“The Court: I asked you to get your view of it, because it would seem to me that although I have submitted the question of validity along with infringement to a jury before, the only question really in these cases, so far as I have been able to see in most cases, anyway, that calls for the trier of fact to act is the infringement issue.

“In that respect in this case if there is validity of the patent, I think the Court would have to instruct the jury that there was infringement, because I do not think that reasonable minds could differ that there is any difference between the two devices. * * *”

Again at R. 224:

“* * * If this patent is valid, then the plaintiff is entitled to a judgment because I think as a matter of law there is just no question about there being infringement. It doesn't take a Philadelphia lawyer to see that that is so. Counsel haven't made any point about that. This case depends upon the validity of the patent.”

CONCLUSION.

The patented invention has presented a structure which enhanced the scaffolding art with a new conception in scaffolding, having new abilities, which patented structure is a new entity having new and additional functions and producing new, or at the very least, greatly improved results, and which operates differently from anything in the prior art.

The patented invention, based on facts which are not in controversy, has been shown to meet every test of invention as laid down by this Court.

It is, therefore, respectfully submitted that the District Court was in error in holding the patent invalid as not being a patentable invention; that the judgment of that Court should be reversed in order that the production of a very

meritorious invention may be rewarded with the protection provided for by our patent laws.

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Respectfully submitted,

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